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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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STORM L.L.P. BANK OF AMERICA PLAZA 901 MAIN STREET, SUITE 7100 DALLAS, TX 75202			PECHHOLD, ALEXANDRA K	
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/723,968	Applicant(s) RIKER, RONALD D.	
	Examiner Alexandra K. Pechhold	Art Unit 3671	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-5, 7-11, 13-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hubbell et al (US 6,409,433) in view of Kubicky (US 6,322,863).**

Regarding claim 1, Hubbell discloses a post capable of being used adjacent roadways for supporting an object, comprising:

- a hollow sleeve, seen as the shell of epoxy resin (7), formed of thermoplastic resin and having an interior surface;
- one end of the sleeve being capable of being received in and supported by a ground surface, and an opposite end of the sleeve extending from the ground surface and being capable of being secured to the object, since it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform; it does not constitute a limitation in any patentable sense (*In re Hutchison*, 69 USPQ 138);

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- a core within the sleeve, seen as structural tubular element (4), seen as coextensive with the interior of the sleeve, and can be made of rubber (Col 6, line 8), wherein the core and sleeve are continuous along the post from the one end to the opposite end, as seen in Fig. 2.

Hubbell fails to disclose the rubber in element (4) as having a recycled rubber component thereto. Kubicky teaches using recycled scrap tires for a utility pole, thereby providing a use for disposed scrap tires, saving forests, and do not have the environmental and structural problems of creosote covered wooden poles, aluminum poles, or concrete poles (Col 2, lines 1-25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the rubber of Hubbell to have a recycled rubber component as taught by Kubicky, since Kubicky notes the environmental advantages of reusing discarded tires in column 2, lines 1-16.

Regarding claim 9, Hubbell discloses the limitations of the claimed invention as discussed with respect to claims 1 and 2 above. Hubbell fails to disclose the rubber in element (4) as having a 10% recycled rubber component thereto. Kubicky teaches using recycled scarp tires for a utility pole, thereby providing a use for disposed scrap tires, saving forests, and do not have the environmental and structural problems of creosote covered wooden poles, aluminum poles, or concrete poles (Col 2, lines 1-25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the rubber of Hubbell to have a recycled rubber component as taught by Kubicky that is 10% by weight recycled rubber, since Kubicky notes the

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environmental advantages of reusing discarded tires in column 2, lines 1-16, and it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claims 16 and 18, Hubbell discloses a sleeve with a circular cross section, and a core coextensive with the sleeve interior as discussed with regards to claim 1 above and seen in Figs. 1 and 2. Hubbell discloses the core (4) as plastic (Col 6, line 8), thereby meeting the polymer limitation. Hubbell fails to disclose the core (4) being at least 10% or 20% by weight recycled crumb rubber and the balance as a low-melt index polyethylene, though Hubbell does disclose that core (4) can be made of various materials, such as plastic and rubber (Col 6, lines 7-9), and polyethylene is a type of plastic. Hubbell fails to disclose that layer (7) is high-density polyethylene, instead disclosing that (7) "can be composed for resin, for example epoxy resin and the like." (Col 6, lines 29-31). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the layer (7) of Hubbell to be high density polyethylene, since Hubbell broadly discloses that the layer (7) may be a type of resin "and the like", which has the similar advantageous structural and durability qualities of high density polyethylene. Kubicky teaches using recycled scarp tires for a utility pole, thereby providing a use for disposed scrap tires, saving forests, and do not have the environmental and structural problems of creosote covered wooden poles, aluminum poles, or concrete poles (Col 2, lines 1-25). It would have been obvious to one having ordinary skill in the art at the time the invention

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was made to modify the rubber and plastic core of Hubbell to have a recycled component thereto as taught by Kubicky, and having at least 10% or 20% by weight recycled rubber, since Kubicky notes the environmental advantages of reusing discarded materials in column 2, lines 1-16, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claims 2, 15, and 20, Figs. 1 and 2 of Hubbell illustrate the (7) and (4) as circular and (4) as hollow.

Regarding claims 3 and 10, Hubbell fails to disclose that (7) is high density polyethylene, instead disclosing that (7) "can be composed for resin, for example epoxy resin and the like." (Col 6, lines 29-31). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the layer (7) of Hubbell to be high density polyethylene, since Hubbell broadly discloses that the layer (7) may be a type of resin "and the like", which has the similar advantageous structural and durability qualities of high density polyethylene.

Regarding claims 4, 5, and 11, Hubbell discloses that core (4) can be composed of various materials, such as concrete, plastic, rubber, structural foam, etc. (Col 6, lines 7-9), which therefore could include a combination of rubber and thermoplastic resin. Hubbell does not disclose that any of these materials are recycled, nor having a certain percentage (10% or 20%) of recycled rubber. Kubicky teaches using recycled scarp tires for a utility pole, thereby providing a use for disposed scrap tires, saving forests, and do not have the environmental

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and structural problems of creosote covered wooden poles, aluminum poles, or concrete poles (Col 2, lines 1-25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the rubber and thermoplastic core of Hubbell to have a recycled component thereto as taught by Kubicky, and having the mixture comprise 10% or 20% by weight recycled rubber, since Kubicky notes the environmental advantages of reusing discarded materials in column 2, lines 1-16, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claims 8, 14, and 17, Hubbell fails to disclose the post having crash properties conforming to NCHRP Report 350. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the post of Hubbell to have crash properties conforming to NCHRP Report 350, since the applicant states in the specification that the standards have been adopted by most states.

Regarding claims 7 and 13, Hansen fails to disclose the sleeve and core as coextruded, instead forming and attaching the layer (7) to the inner core (4) (Col 6, lines 43-57). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the means by which the core and layer of Hansen are made and joined so that they are coextruded, since either process would still result in the same finished product with the layer (7) being joined directly against the core (4) with no disjunction or disjointedness, since the Figures show a direct continuous interface between these layers.

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3. **Claims 6, 12, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hubbell et al (US 6,409,433) and Kubicky (US 6,322,863) as applied to claims 1, 9, and 16, respectively above, and further in view of Hansen (US 2003/0072904).** The combination of Hubbell and Kubicky fails to disclose a highway sign of an area of less than 10 sq. ft. Hansen teaches a utility pole, guardrail, a signpost, and may be suitable for many other construction applications (para. 20), much like the pile structure of Hubbell. Hansen fails to disclose the area of the signpost. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hubbell to support a signpost as taught by Hanson, since Hanson states in para. 20 the multiple uses of such a pole or post, such as supporting a sign, and with respect to the 10 sq. ft size, discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

Response to Arguments

4. Applicant's arguments filed 12/12/05 have been fully considered but they are not persuasive.

The applicant argues that the claimed invention is in stark contrast to the foundation piling of Hubbell, since Hubbell discloses the formation of "portals" in the conduit, which interrupts the continuity of the structure. The applicant cites support for this argument by Hubbell's disclosure in column 7, lines 1-14, where Hubbell states that

“[p]lacement of strain-gages on the post-tensioning strands, after post tensioning via sealable, and/or resealable portals into the structure’s post-tensioning conduit, allows for monitoring of structural integrity during manufacturing, transport, installation activities and after installation for monitoring of load displacements before, during and after placement of superstructure on the installed pile foundation.”

The structure in Hubbell that the Examiner is using to meet the claimed recitation is a hollow sleeve seen as the shell of epoxy resin (7), and a core within the sleeve, seen as structural tubular element (4). The strain-gages that Hubbell discloses are placed on the post-tensioning strands, which are located inside the hollow space in the conduit (2). Therefore, it does not appear that they must interrupt the continuity of the core and sleeve. The applicant appears to be arguing more than is actually disclosed by Hubbell.

The applicant also argues that Hubbell structure is sunk into the ground and need not concern itself with either supporting a structure such as a highway sign unassisted by surrounding earthen formation or with its failure mode if struck by a vehicle. Applicant’s arguments appear to be extending beyond the scope of the claims. For instance, claim 1 only positively recites a post, and then recites the intended use recitations “for use adjacent roadways” and “for supporting an object”. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In response to applicant's argument that Hubbell is nonanalogous art, it has been

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held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Hubbell discloses "a post", which is in the field of the applicant's endeavor.

The applicant also disagrees with the Examiner's application of Hubbell with the teaching of Kubicky. The Examiner maintains the rejection, on the grounds that Kubicky teaches using recycled scrap tires for a utility pole, thereby providing a use for disposed scrap tires, saving forests, and do not have the environmental and structural problems of creosote covered wooden poles, aluminum poles, or concrete poles (Col 2, lines 1-25).

The applicant also argues that Hansen cannot be used to reject the claims since Hanson involves forming a post-like structure by winding strips formed from old tires in a spiral fashion about a mandrel, thus intentionally and inherently introducing discontinuity (and thereby not meeting the claimed recitation of being continuous). The Examiner maintains that any supposed discontinuity in Hanson is irrelevant, since Hanson is being used to rejected the claims that recite that the object is a highway sign having an area of less than 10 square feet. The primary, base reference, Hubbell, already discloses the continuous limitation, and Hanson is being used for the teaching a highway sign. The claim rejections specifically address this, since Hanson states in para. 20 the multiple uses of such a pole or post, such as supporting a sign.

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Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexandra Pechhold whose telephone number is (571) 272-6994. The examiner can normally be reached on Mon-Thurs. from 8:00am to 5:30pm and alternating Fridays from 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached on (571) 272-6998. The fax phone number for this Group is (703) 872-9306.


Thomas B. Will
Supervisory Patent Examiner
Group 3600

AKP
1/26/06